

REMARKS

In this application, claims 1-71 are pending. In the pending Office Action, Examiner Snow made a restriction requirement between the following groups of claims:

- I. Claims 1-34, drawn to method for intervertebral stabilization, classified in class 623, subclass 17.11.
- II. Claims 35-71, drawn to a system for stabilizing a spinal column segment, classified in class 623, subclass 17.12.

The above language concerning the examiner's groups is taken verbatim from the Office Action for the sake of clarity, and is not intended as an admission of any sort as to the subject matter or classification of any claim.

As Examiner Snow's restriction requirement relied on the provisions of 35 U.S.C. § 121, which makes restriction permissive, per standard PTO practice noted in MPEP 803 and 808.02 this application should be examined as a whole if it can be done without undue burden on the examiner. Accordingly, Applicants elect Group I (claims 1-34) for prosecution, with traverse on the grounds that searching and examining the entire application can be made without serious or significant additional burden. The Office Action suggests that the claim groups are related as product and process of use, and that the claims are classified in the same class and in subclasses that are immediately next to each other in the PTO classification. Assuming that product/process assessment to be true, then all of the searching relevant to the product will also be relevant to the process, and vice versa. Respectfully, most or all of the searching required for group II will be the same as that for group I, and will cover both of the subclasses identified by the examiner, which are very closely related. Such searching and consideration will be required for proper

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examination of both sets of claims. Thus, not only will the search subclasses be substantially or completely identical for both sets of claims, but the references sought in those subclasses will be at least highly similar, if not identical. In other words, most or all of the references, if any, that are relevant to one set of claims will likely be relevant to the other set of claims. Since the research and analysis effort required for examining one set of claims will be essentially the same as for examining both sets of claims, it is respectfully submitted that there can be no significant extra burden in searching and examining both sets of claims. Per MPEP 803 and 808.02, the restriction requirement should be withdrawn and all pending claims should be examined.

The pending Office Action also made a requirement for election of species, which is also traversed. Examiner Snow indicated the opinion that this application "contains claims directed to the following patentably distinct species," but did not identify the alleged species. Rather, he required the election of "an ultimate embodiment of delivery device, expandable device, and motion preserving device for prosecution[,] fully describing said elected embodiment including shape and materials and specifically indicating what figures the elements are shown [sic]." He further charged that these unnamed species "are independent or distinct because the embodiments vary in structure, function, and/or capabilities; they have patentably distinct elements."

Respectfully, the Office Action does not provide sufficient information either to establish the propriety of the election requirement, or to allow the Applicant to make a proper choice. First, it is respectfully submitted that the Office Action does not provide a sufficient evidentiary basis for the election requirement. In order to make a proper election requirement, "[t]he particular reasons relied on by the examiner for holding that the inventions as claimed are either

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independent or distinct should be concisely stated. A mere statement of conclusion is inadequate." MPEP 808.01 (emphasis added). Moreover, "[w]here there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction." MPEP 808.01(a).

Respectfully, the Office Action falls short. All it gives are the merely conclusory statements that the supposed species "vary in structure, function and/or capabilities" and they "have patentably distinct elements." These statements do not provide the required discussion of the relationship of the alleged species and reasons to support the conclusion. Indeed, the first statement does not identify whether it is structure, function or capability that the Office Action relies on, and neither statement gives any example or other basis for the conclusion. No citation to the application, discussion of embodiments, or other evidence or grounds for that conclusion was provided. Further, there is no evidence that the Office Action considered whether generic claims were in the application. Without that assessment, a conclusion as to distinctness of species cannot be drawn. As noted above, the MPEP defines as inadequate the conclusion of restrictability without basis. Further, the application itself discusses the relationships between the species alleged in the Office Action. The Office Action does not discuss those relationships or provide any reasons why they do not prevent restriction. For at least these reasons, the election requirement does not meet the required threshold, and should be withdrawn.

Second, the Office Action does not provide sufficient information for Applicant to make an informed election. No particular embodiments or references to figures in the application are

made, as is common in election requirements. Rather, the Office Action essentially requested

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the Applicant to make its own species determinations with its request to specify in what figures the elected species are shown. The rules place the burden on the examiner to identify putative independent species, of which the Applicant can elect or otherwise respond. Respectfully, the examiner has not acted properly in devolving that burden onto Applicant. Further, the ambiguous nature of the requirement, in requesting an "ultimate embodiment," and its request for identification of shape and materials, features that are not present in most of the claims, show that the election requirement is overbroad.

Additionally, the Office Action relied on the provisions of 35 U.S.C. § 121, which makes restriction permissive, in requesting that Applicant elect a single species. Section 121 permits limitation to a "reasonable number" of species. The embodiments shown and described in this application are a reasonable number for consideration, and the election requirement does not suggest otherwise. Further, the similarities among the embodiments are such that they can all be efficiently considered together when the claims are searched and examined. If "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions." MPEP 808.02. The Office Action does not allege that the classification of the alleged species is different, and it seems likely that all such species would be commonly classified. The Office Action asserts the bare conclusion that a different field of search would be required, but does not provide any evidence to support that conclusion. It is not apparent from the record that any searching would be necessary for one species "that is not likely to find art pertinent to the other[s]." Id. Rather, it is believed that any practical and reasonable search strategy for one species would find references pertinent to all species. Finally, no suggestion

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was provided that the alleged species would be separately classified or searchable in the future. No patents or other evidence of a separate field of search was provided, as MPEP 808.02 requires. A proper election requirement "must show by appropriate explanation" (1) separate classification, (2) separate status in the art, or (3) a different field of search. Id. Because the Office Action does not provide the necessary evidence and explanation, the election requirement should be withdrawn.

The Office Action's request for a listing of the pending claims that read on the provisionally-elected species is respectfully objected to as improperly devolving the responsibilities of the PTO onto the Applicants. The PTO has the burden of proof to provide evidence and a sufficient showing that claims in an application are unpatentable, or should otherwise be excluded from an application. Further, as noted above, the Office Action does not provide sufficient information for defining what would be a proper election, and thus it is not possible to ensure a proper identification of claims.

It will nevertheless be attempted to provide an election that is deemed proper so as to attempt a complete response for the sake of efficiency. Accordingly, subject matter is elected that includes "expandable device" 30, "delivery device" or "instrument" 50, and "motion preserving device" 270, as described and shown in the text and figures of this application, with traverse. Given the breadth of the specification and the claims, at least claims 1-31 and 33-34 read on that subject matter. Further, at least claims 1 and 19 among the method claims in this application, and others among the system claims, are generic to the embodiments shown in this application. Applicants do not concede the propriety of the Examiner's request, and do not

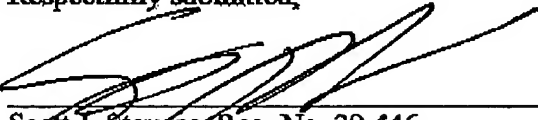
intend to limit in any way the scope of the claims of this application with the statements or
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provisional election herein. Specifically, the claims in this application should be given the full scope permitted by their language. Applicant reserves the right to later assert that other claims read on the provisionally-elected species as well, especially if the election requirement is not withdrawn. No amendments have been made to the claims.

Traversal is based at least on the reasons noted above, including a lack of support for the election requirement both as a matter of fact and of law, the fact that there is no showing that the alleged species constitute an unreasonable number, the lack of significant extra burden on the examiner in examining all claims, and the presence of claims generic to the alleged species. For at least these reasons, the election requirement should be withdrawn, and all claims should be examined.

In conclusion, Applicant has made a provisional election as noted above with traverse. Examiner Snow is respectfully requested to reconsider the present election requirement and withdraw it. An Office Action toward a Notice of Allowance in this case is respectfully solicited.

Respectfully submitted,



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